

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

MCCORMACK, Derek
Motorola European Intellectual
Property Operations
Midpoint, Alencon Link
Basingstoke, Hampshire RG21 7PL
GRANDE BRETAGNE

PCT

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19 AUG 2004
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WRITTEN OPINION
(PCT Rule 66)

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Applicant's or agent's file reference
CE10051EP/LL

REPLY DUE within 2 month(s)
from the above date of mailing

International application No.
PCT/EP 03/05505

International filing date (day/month/year)
23.05.2003

Priority date (day/month/year)
27.09.2002

International Patent Classification (IPC) or both national classification and IPC
H04Q7/38

Applicant
MOTOROLA INC et al

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 27.01.2005

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Name and mailing address of the international preliminary examining authority:



European Patent Office
D-80298 Munich
Tel: +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized Officer

Hodgins, W

Formalities officer (incl. extension of time limits)

Finnie, A

Telephone No. +49 89 2399-8251



I. Basis of the opinion

1. With regard to the elements of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-30 as originally filed

Claims, Numbers

1-28 as originally filed

Drawings, Sheets

1/2-2/2 as originally filed

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
 - ☐ the language of publication of the international application (under Rule 48.3(b)).
 - ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).
3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority in written form.
 - ☐ furnished subsequently to this Authority in computer readable form.
 - ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
 - ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
4. The amendments have resulted in the cancellation of:
- ☐ the description, pages:
 - ☐ the claims, Nos.:
 - ☐ the drawings, sheets:
5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).
6. Additional observations, if necessary:

WRITTEN OPINIONInternational application No. **PCT/EP 03/05505****V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims	1, 2, 14, 18, 19, 23 - 27
Inventive step (IS)	Claims	3-13, 15-17, 20-22, 28
Industrial applicability (IA)	Claims	

2. Citations and explanations**see separate sheet**

Concerning Point V

- 1) The following documents are cited:
D1: WO 02/073366 A (MASHINSKY ; ROSEN CLIFFORD (US)) 19 September 2002 (2002-09-19)
D2: EP-A-0 888 025 (AT & T CORP) 30 December 1998 (1998-12-30)
D3: WO 02/061968 A (ERICSSON TELEFON AB L M) 8 August 2002 (2002-08-08)
D4: US 2002/087674 A1 (ZHAO HONG ET AL) 4 July 2002 (2002-07-04)
D5: WO 01/59986 A (ERICSSON TELEFON AB L M) 16 August 2001 (2001-08-16)
D6: WO 01/80589 A (LE BODIC GWENAEL ; DUNLOP JOHN (GB); GIRMA DEMESSIE (GB); IRVINE JA) 25 October 2001 (2001-10-25)
- 2) Claim D1 claims a resource management apparatus for a cellular communication system comprising a resource controller operable to allocate a radio resource to a subscriber unit in response to an operator identity associated with a service of the subscriber unit, such that different quality of service is achieved for different operators.

This is so broad that it can be read onto how everyday GSM systems function.

For example, the examiner (resident in Germany) has a contract to use the D2 (Vodafone - not to be confused with the document numberings above) network. Should, on turning on his mobile device in Germany, the device due eg to heavy local network use, not be able to camp on a D2 channel, the device will attempt to camp on a D1 (T-Mobile) channel. In an area theoretically covered by his home D2 network, this will fail, with a message along the lines of "not allowed to access "foreign" network". Thus the D1 network will provide a different quality of service for the subscriber unit for different operators, ie normal quality for D1 and none what so ever for D2. (Note: this is similar to what is described in document D4 cited above.)

Alternatively, consider the provision of MMS services to mobile subscribers. MMS has to be activated by a network operator. If a subscriber with a subscription with an operator who doesn't provide MMS roams into an area covered by an operator who does, then this subscriber will still not be provided with an MMS service. Again, a different quality of service has been achieved for different operators, depending on

whether they allow MMS or not.

Claim 1 is thus not new within the meaning of Article 33(2) PCT when regard is had for how everyday GSM systems function.

3) Turning now to the above cited prior art,

D2 describes a method and apparatus for providing partitioned telecommunication service (see document in general, but passages cited in search report in particular and figure 2 and the functioning of MSC 202 described in the related parts of description). According to the last two sentences of the abstract, the switch "upon determining the service provider ... will retrieve the subscriber's profile ... then provides services in accordance with the retrieved profile" (see also figure 4). In the light of the background of D2 (column 1 lines 31 - 38) it is clear that this provision of services according to a retrieved profile, the profile being dependent upon the operator identity is identical as the subject matter of claim 1.

Claim 1 is thus not novel over D2 within the meaning of Articles 33(1) and (2) PCT.

Moreover, even if, on the basis of some not apparent detail or interpretation of wording the applicant were able to establish the newness of claim 1, it is clear that from the starting point of D2 the skilled man would be able to arrive at the claimed subject matter without performing an inventive step within the meaning of Article 33(3) PCT.

Moreover, D3 (see for example abstract and claim 1) relates to controlling the quality of service for multiple services that share a common resource. This is done for "service groups". D3 is silent as to what a service group is. If this is to be viewed as being operator dependent, then from the starting point of this document the skilled man would arrive at the claimed subject matter without performing an inventive step within the meanings of Articles 33(1) and (3) PCT.

3) Similar comments to the above apply also to independent claim 26, which relates for the method category to independent apparatus claim 1. Claim 26 is thus also not new (or at the least not inventive) for the reasons set out above, and is thus also fails to

meet the above mentioned Articles of the PCT. Similar comments apply to claim 23 relating to a system comprising an apparatus as per claims 1 - 22.

- 4) None of the dependent claims adds anything novel or inventive to their respective independent claims when regard is had for D1 - D6 mentioned above. These claims thus also fail to meet the requirements of Article 33 PCT due to the lack of novelty or inventiveness of their subject matter as indicated on the attached cover sheet.
- 5) It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable an independent claim including such matter should be filed.

The applicant should also indicate in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art and the significance thereof.

- 6) For the sake of completeness, the following is noted:
 - i) The independent claims should be put in the two part form recommended by Rule 6.3(b) PCT with a pre-characterising part reflecting the teachings of the closest prior art.

If, however, the applicant is of the opinion that the two-part form would be inappropriate, then reasons therefor should be provided in the letter of reply. In addition, the applicant should ensure that it is clear from the description which features of the subject-matter of the independent claims are known from the prior art (cf. the PCT Guidelines PCT/GL/3 III 2.3a).

- ii) In order to meet the requirements of Rule 6.2(b) PCT reference signs in parenthesis should be added to the claims. This applies both to the pre-amble and to the characterising part, and to method claims in as far as they refer to apparatus features.
 - iii) In order to meet the requirements of Rule 5.1(a)(ii) PCT, at least the documents D2 and D3 should be cited in the description and briefly discussed.
 - iv) If necessary, the description should be brought into conformance with any newly

filed claims. In this respect it is noted that not only the part of the description according to Rule 5.1(a)(iii) PCT but also that part according to Rule 5.1(a)(v) PCT may require some amendment, in particular in the light of the repeated use of the work "embodiment" throughout and in the light of the final paragraphs, some of which seem to correspond closely to the claimed subject matter.

- v) Article 34(2)(b) PCT must be observed when amending.